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09/612,407	07/06/2000	Junichi Umehara	9366/203	7124

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EXAMINER
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GARG, YOGESH C

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 06/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/612,407

Applicant(s)

UMEHARA, JUNICHI

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-67 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-67 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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## DETAILED ACTION

### *Response to Amendment*

1. Amendment a, paper # 8, received on April 1, 2003, is acknowledged and entered. Claims 1, 5-7, 13, 16, 20, 22, 23, 30, 42, 46, 50, and 54 have been amended. Currently claims 1-67 are pending for examination.

### *Response to Arguments*

2. With regards to the applicant's arguments (see amendment. Pages 6-7), rejection of claim 35 under 35 USC 112, first paragraph, is withdrawn. However, examiner notes that page 9, line 21 to page 10, line 5 of the specification makes a statement of printing requested indicia on the CD ROM but does not describe or state any details about the printing device, structurally or functionally, which prints the indicia on the CD-ROM. Therefore, it is obvious that the applicant admits printing on CD ROM as prior art.

With regards to the applicant's arguments with respect to claims 5-7, 9, 16, 22, and 27 (see amendment, page 7) filed on April 1, 2003 and necessary amendments made to them their rejection under 35 USC 112, second paragraph, is withdrawn.

Applicant's arguments with respect to amended claims 1-67 filed on April 1, 2003 have been considered but are moot in view of the new ground(s) of rejection necessitated due to the amendment to all the independent claims 1, 20, 23, 30, 46, 50, and 54 by adding a new limitation that " data/document contained within an image file " and adding "service provider " in claim 42.

With regards to the applicant's arguments for providing an affidavit in support of the Official Notice taken with respect to claims 11-13, 15, 18-19, 38-40, 57-59, 61, and 64-65 (see

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amendment pages 9-10), following references are enclosed to state that printing original financial certificates, tickets, stamps, or credit/debit/pre paid cards: (i) US Patent 6,538,757 B1 to Sansone teaches printing tickets (see at least col.1, lines 39-43, col.3, line 63-col.4, line 15), US 2003/0081824 A 1, to Mennie et al. teaches printing of stock certificates, checks, bonds, and postage and food stamps, and all other financial documents (see at least page 10, paragraph 01666), (iii) US Patent 5,558,021 to Erhard et al. teaches printing credit/debit and plastic cards, which include pre-paid cards (see at least col.1, lines 24-44). Note: It was noted in the earlier Office Action (see page 7, "...Note: disclosure admits.....from a remote source) that the applicant has admitted that printing original financial certificates, tickets, stamps, or credit/debit/pre paid cards is a prior art (see specification, page 6, lines 6-10 and page 10, lines 6-11) to which applicant did not respond.

With regards to the applicant's arguments for providing an affidavit in support of the Official Notice taken with respect to claims 6, 22, 27, 42-45, and 66-67 (see amendment page 10), following references are enclosed which teach that the provider/intermediary can detect and confirm that the printer has sufficient supplies and replenish the printer with supplies: (i) US Patent 6,363,359 to Gronemeyer et al. (see at least col.6, line 34-col.8, line 35) and (ii) US Patent 6,023,593 to Tomidokoro ( see at least abstract, col.1, line 66-col.2, line 34).

With regards to the applicant's arguments for providing an affidavit in support of the Official Notice taken with respect to claims 32, and 36-37 (see amendment page 11), following reference is enclosed which teach defacing or voiding a printed instrument like a check: (i) US Patent 6,547,132 to Templeton (see at least col.7, lines 41-44).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3.1. Claims 1-5, 7-9, 14, 16-17, 20-21, 23-26, 28-29, 30-31, 33-35, 41, 46-56, 60, and 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan and further in view of Harvey et al. (US Patent 6,026,385), hereinafter, referred to as Harvey.

3.2. With regards to claims 1-5, 20-21, 23-26, 30-31, and 46-56, Ryan teaches a method, a system and a printing device for conducting electronic transactions comprising: establishing a first communication connection to a provider from a consumer, and said communication connection is via Internet or optical communication or wire less medium, submitting a request for transaction with consumer's identification and printer identification information, provider processing said transaction and generating electronic certificated data, establishing a second communication by provider to consumer to transmit said authorized electronic certificate data and printing instructions to the consumer's printer without involvement of a consumer or a consumer's computer, and provider controlling the printing of an electronic certificate on the consumer's printer, acknowledging receipt of said printing data directly to said remote provider, (at least see col.3, line 36-col.5, line 36 & Figs.1-2. Note: Data center 20 corresponds to the provider in the application. Indicia data corresponds to electronic certificate data and the printer module at the consumer's end prints it. The printing of electronic certificate data at the consumer's printer is controlled by the PSD at Data center without involvement from

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consumer or consumer's computer the data center verifies that the printer module is authorized to print that authorized document data (at least see col.3, lines 40-45). At step 135, Fig.2, printer acknowledges receipt of the printing data from the provider directly. Col.4, lines 58-60 teach communication connection is via Internet or optical communication or wire less medium. Note: It is inherent that printers would function in response to drivers either on the resident driver or to a remote driver.).

Ryan does not teach that the printing data such as electronic certificate/document contains an image file. However, in the same field of postage indicia printing and from the same assignee, Pitney Bowes Inc., Harvey teaches that the printing data such as electronic certificate/document contains an image file (see at least col.2, line 29-col.3, 53, "... *The present invention.....print processing application or print image manipulation application.....The application supplies a modified print file containing the final print images for the documents .....*", col.5, lines 13-17, "... *The applications 19 facilitate batch processing to produce print files 21, containing large numbers of document images.....*", col.12, lines 20-34, col.14, lines 6-34, col.19, lines 5-16,). In view of Harvey, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Ryan to include the feature that the printing data such as electronic certificate/document contains an image file because when the printing data is in the form of image it helps to merge a number of images such as merging the image of an address into the print image of a document as explicitly disclosed in Harvey (see at least col.2, lines 46-55).

3.3. With regards to claims 7-9, 28-29, Ryan/Harvey further teaches providing an identification indicia for printing on said electronic certificate, transmitting it to the consumer's printer with the image file and printing the identification indicia on said electronic certificate, confirming that said indicia was printed on said electronic certificate and maintaining print-

confirmation for said electronic certificate by said provider (at least see Ryan, col.3, lines 49-col.4, lines 24, col.5, lines 9-29, and col.5, line 58-col.6, line 8). Ryan/Harvey also discloses printing authentic certificates of different dimensions (at least see Ryan, col.4, lines 30-32. Envelope and metering tape correspond to certificates of different dimensions).

3.4. With regards to claims 14, and 60, Ryan/Harvey teaches printing original postage label and an associated pick-up schedule label (at least see Ryan, col.4, lines 26-50, "...print directly on envelopes or meter tape.....label printer ". Note: label printer can print postage label as well pick-up schedule label).

3.5. With regards to claims 16-17, 41 and 62-63, Ryan/Harvey discloses requesting the user to make payment and print original receipt (at least see Ryan, col.5, lines 46-57).

3.6. With regards to claims 33-35, they are dependencies of an apparatus claim 30 but their limitations "wherein said printing data is printed on paper/plastic/CD ROM" are mere intended functions rather than structural elements further limiting the apparatus claimed in claim 30. For apparatus claims, analysis to distinguish them from the prior art should be on the basis structural elements rather than intended function. See MPEP 2114 :Apparatus and Article Claims — Functional Language [R-1]. APPARATUS CLAIMS MUST BE STRUCTU-RALLY DISTINGUISHABLE FROM THE PRIOR ART >While features of an apparatus may be recited either structurally or functionally, claims<directed to >an< apparatus must be distinguished from the prior art in terms of structure rather than function. >In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference); see also In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971);< In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims

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cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original). MANNER OF OPERATING THE DEVICE DOES NOT DIFFERENTIATE APPARATUS CLAIM FROM THE PRIOR ART. A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ..., said mixing means being stationary and completely submerged in the developer material”. The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.). Since claims 33-35 does not further limit the apparatus claim 30 and merely state intended function they are not considered to have patentable weight.

4. Claims 6, 10, 11-13, 15-19, 22, 27, 38-40, 42-45, 57-59, and 61, 64-65 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan/Harvey.

4.1. With regards to claims 6, 22, and 27, Ryan/Harvey teaches a method and system for conducting electronic transactions as disclosed in claim 1, 20 and 23 and analyzed above. Ryan/Harvey does not teach that said provider confirming that said printer has sufficient supplies and replenishing said printer with supplies. Official Notice is taken of the notoriously known concept and benefits of confirming the said printer has sufficient supplies and replenishing said printer with supplies. It is knowledge generally available that in order to print



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printer must be equipped with all supplies and if any supplies like ink cartridges and paper or medium on which printing is to be done are not there or exhausted then they have to be replenished. Doing so would ensure to execute the functions of the printer to print the desired indicia and would not delay or stop the work.

4.2. With regards to claims 42-45, their limitations correspond to the limitations of claim 6 and are similarly analyzed and rejected.

4.3. With regards to claim 10, Ryan/Harvey teaches a method for conducting electronic transactions as disclosed in claim 1, and analyzed above. Ryan/Harvey does not teach using bar code for identification indicia. Official Notice is taken of the notoriously known concept and benefits of printing bar codes to represent binary information for numbers, letters, or a combination of two, on books, grocery, items, merchandise, etc., that can be read by an optical scanner. Doing so ensures a rapid and error-free input to identify an item, as described above.

4.4. With regards to claims 11-13, 15, 18-19, 38-40, 57-59, 61, 64-65, Ryan/Harvey teaches a method and a printing device, for conducting electronic transactions, transmitting a selected indicia on a remote printer and printing it as disclosed in claims 1, 30, and 54 and analyzed above. Ryan/Harvey does not disclose printing original financial certificates, tickets, stamps, original credit, debit and pre-pay cards with suitable available printers. Note: disclosure admits using suitable printers to print these items (page 6, lines 6-10 and page 10, lines 6-11) and does not teach the special means required for each time of item listed above. It is, therefore, understood that applicant admits that suitable printers are a prior art available at the time of the invention to print these items if data is downloaded to these printers from a remote source. Ryan/Harvey also discloses transmitting data from a remote source to a printer to print the desired indicia on any medium. Official Notice is taken of the concept and benefits of

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printing original financial certificates, tickets, stamps, original credit, debit and pre-pay cards with suitable available printers. Doing so would ensure a rapid, economical and error-free transaction of printing original financial certificates, tickets, stamps, original credit, debit and pre-pay cards with suitable available printers.

5. Claims 32, and 36-37 are, rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan/Harvey and further in view of Golden et al. (US Patent 5,761, 648).

5.1. With regards to claim 32, Ryan/Harvey teaches a printing device, for conducting electronic transactions, transmitting a selected indicia on a remote printer and printing it as disclosed in claim 30 and analyzed above. Ryan/Harvey does not disclose means for canceling a printed material and for sending information about cancellation to said remote printer. However, Golden, in the field of remote printing of coupons on electronic networks, teaches disclose means for canceling a printed material and for sending information about cancellation to said remote printer (col.4, line 54-col.5, line 23, "...download new instructions.....change old instructions...modify instructions...Previously issued coupons could also be deleted.....expiration date.....Further, the issuer can update reports...based on the number of coupons selected 22, printed 23, and redeemed 24....print commands 28.....". Note: Modification or deletion of earlier instructions for printing coupons correspond to canceling a printed material.). It would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Ryan/Harvey and include the concept of canceling a printed material and sending information about cancellation to remote provider. Doing so would enable issuers of printed material to download new instructions to change the printed material if required like expiration dates and to control the distribution, as suggested in Ryan/Harvey (col.4, lines 60-67,, "...and commands to set expiration dates...limit coupon distribution by area....).

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5.2. With regards to claims 36 and 37, Ryan/Harvey/Golden teaches a printing device, for conducting electronic transactions, transmitting a selected indicia on a remote printer and printing it, canceling the printing material as disclosed in claim 32 and analyzed above. Ryan/Harvey/Golden does not disclose defacing said printed material and sending identification information read from said printed material or image of said printed material in defaced form to said remote provider. Official Notice is taken of both the notoriously well-known concept and benefits of disclose defacing said printed material and sending identification information read from said printed material or image of said printed material in defaced form to said remote provider. Doing so enables user, as in the case of canceled checks, tickets, unused coupons, promissory notes or any other agreement/document to present a proof of cancellation of the said certificates and to get the reimbursement if applicable.

6. Claims 66-67 are, rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan/Harvey and further in view of Official Notice.

6.1. With regards to claims 66-67, Ryan/Harvey teaches a method, for printing original documents on a remote printer, as disclosed in claim 54 and analyzed above. Ryan/Harvey does not disclose use of an intermediary while transmitting first and second electronic certificate data to a remote printer and that intermediary provides maintenance for the printers. Official Notice is taken of the knowledge generally available about the concept and benefits of using intermediaries both in conventional business (without online) and online business are well known. Use of intermediaries in online business is expected to include online transmitting, downloading and printing of first and second electronic certificate data on a remote printer. By doing so, it will help to more efficient fulfillment of orders online and reduce

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administrative and home delivery costs of replenishing parts and supplies to the printer and improve the availability.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US Patent 6,562,553 B2 to Mancini et al. (see at least col.3, line 57-col.4, line 13) and US Publications 2002/0114627 A1 to True et al. (see at least abstract, FIG.2, Page 1, paragraph 0006) and US 2002/0145636 A1 to Jones et al. (see at least abstract, page 1, paragraphs 0002, 0015).

(ii) US Patent 6,384,923 B1 to Lahey (see at least col.5, lines 59-67), and US Publication US 2001/0014164 A1 to Daniels et al. (see at least page 2, paragraph 0023) teach that printing data includes image files.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

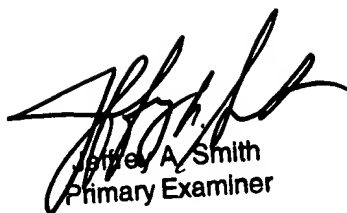
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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Yogesh C Garg  
Examiner  
Art Unit 3625

YCG  
June 2, 2003



Jeffrey A. Smith  
Primary Examiner